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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/486,913 06/07/95 HIATT

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EXAMINER

12M1/0623

LENER, DAVID, LITTENBERG, KRUMHOLTZ, &
MENTLIK
600 S. AVENUE WEST
WESTFIELD S NJ 07090

ART UNIT: PAPER NUMBER

1211

DATE MAILED: 06/23/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3/24/97 & 4/2/97 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-6 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 2-6 are allowed.
4. ☒ Claim 1 is rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

08/486913

EXAMINER'S ACTION

Art Unit: 1211

1. Claims 1-6 are pending in this application.
2. The rejection of claim 4 under 35 USC 112, second paragraph, is moot in view of the amendment to claim 4 received March 24, 1997.
3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 08/486535. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Further, applicants have stated at page 4, first paragraph, of the amendment received March 24, 1997: "Next, claim 1 was provisionally rejected under 35 USC 101 as claiming the same invention as that of claim 1 of co-pending Application Serial No. 08/486,535. The

Art Unit: 1211

identically claimed subject matter is hereby acknowledged.” Accordingly, the rejection of claim 1 under the 35 USC 101 statute has been maintained.

4. The rejection of claim 1 under 35 USC 103 is withdrawn in view of the claim amendment received March 24, 1997.

5. Applicant's arguments filed March 24, 1997 have been found persuasive for the rejection of claim 1 under the 35 USC 103 statute. However, the rejection of claim 1 under 35 USC 101 has been maintained for reasons given above.

6. Claims 2-6 are allowable over the prior art of record.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Serial Number: 08/486913

Page 4

Art Unit: 1211

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication should be directed to Louise Leary at telephone number (703)308-3533 .


LOUISE LEARY
PATENT EXAMINER
GROUP 1200

June 19, 1997